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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/112,020 07/08/98 ADKI

K 1945-104R

EXAMINER

LM02/0401

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ART UNIT

PAPER NUMBER

2746

DATE MAILED:

04/01/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/112,020**

Applicant(s)  
**Aoki et al.**

Examiner  
**Edward F. Urban**

Group Art Unit  
**2746**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-18 is/are allowed.

☒ Claim(s) 19-22 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/208,707.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Reissue Applications***

1. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman in view of Crane et al.

Wiedeman discloses a mobile communication terminal equipment 501 containing a satellite transceiver 520 including a satellite transmission/reception circuit for communicating with a satellite system, a terrestrial transmission/reception circuit 503 for communicating with a terrestrial system, a signal input/output for inputting and outputting signals to/from the user and a connection controller and switching means 530,531 for selectively connecting the signal input/output circuit to one of the satellite transceiver and terrestrial transceiver. Wiedeman does not disclose a portable set disconnectable from the satellite transceiver. However, Crane et al. disclose a portable set 305 for communicating to a local area, terrestrial system when disconnected from a wide area transceiver 301,303, but can communicate and connect with a wide area network or local network when connected with wide area transceiver 301,303 (col.4, line 12 - col. 5, line 12). Therefore, it would have been obvious to one having ordinary skill in the

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art to apply this portable unit communication technique of Crane et al. to the system of Wiedeman for the purpose of allowing the phone to be more compact when only communicating with a closer, more local system. As to the wider area network being able to communicate with a satellite system, such would have been obvious to one of ordinary skill in the art since one would want to communicate at a much farther distance. It is considered that the above modified system contains satellite and terrestrial control means (contained in microprocessor 301) for controlling signal transmission and reception and command input means for inputting a user's command relating to the operation of the switching means as recited in claims 20-22. It is also considered that particular control signals are transmitted between the satellite and terrestrial control means and command input means in order for the device to properly operate and switch to the appropriate communication system.

***Allowable Subject Matter***

5. Claims 1-18 are allowed.

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*Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Urban whose telephone number is (703) 4385.

EFU

March 29, 1999

  
EDWARD F. URBAN  
PRIMARY EXAMINER